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| EXAMINER |
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ZECHER, MICHAEL R

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| ART UNIT | PAPER NUMBER |
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3691

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01/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/707,327

Applicant(s)

GERSTNER ET AL.

Examiner

MICHAEL R. ZECHER

Art Unit

3691

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

/Michael R. Zecher/
Art Unit #3691

In regards to Applicant's argument against the 35 U.S. C. 112, second paragraph, rejection, the Examiner respectfully disagrees. For a computer-implemented means-plus-function claim limitation that invokes 35 U.S.C. 112, sixth paragraph, the corresponding structure is required to be more than simply a general purpose computer or microprocessor. The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor. The written description of the specification must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the disclosed algorithm that performs the claimed function. See *Artistocrat Technologies, Inc. v. International Gaming Technology*, 184 F.3d 1328, 1338, 86 USPQ2d 1235, 1243 (Fed. Cir. 2008). Applicant may express the algorithm in any understandable terms including as a mathematical formula, in prose, in a flow chart, or in any other manner that provides sufficient structure. See MPEP 2181 for examples where the courts held that the corresponding structure is adequate for the computer-implemented means-plus-function claim limitations. The Examiner maintains that a rejection under 35 U.S.C. 112, second paragraph, is appropriate because the written description of the specification discloses no corresponding algorithm.

In regards to Applicant's argument against the 35 U.S.C. 101 rejection, the Examiner respectfully disagrees. During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard: The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In *re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

In this case, Applicant states that the system of the invention can include various engines and data repositories that work together to provide the means for implementing embodiments of the invention. Some of these can be implemented manually or using paper-based means. Even in embodiments where all of the engines and data repositories are computerized, the creation and use of paper records as part of the processes disclosed can be supported (See paragraph 7 of the specification). Since Applicant's specification indicates an embodiment whereby the "means for receiving," "means for matching," "means for forwarding," etc. lack storages on a medium, no underlying functionality occurs and thus there is no practical application (e.g. engines and repositories are clear indicia that Applicant intended a software application). The Examiner maintains that the means-plus-function language does not positively insert hardware into the claim construction, thus a broad interpretation of claim 21 can be software only.

In regards to Applicant's argument against 35 U.S.C. 102(e), the Examiner respectfully disagrees. Based on a broad and reasonable interpretation, the Examiner has identified that the recited elements are disclosed, taught, and suggested in the prior art. First, *Neofytides et al.* clearly teaches reoccurring transactions (See col. 1, line 57, through col. 2, line 2). Second, *Neofytides et al.* clearly teaches that individuals initiate bank account debits in an electronic monetary transaction (See col. 5, line 38, through col. 6, line 9). It is inherent that bank accounts are held within banks or financial institutions. Although financial institutions are not expressly disclosed, they are implicit to one of ordinary skill in the art. Third, *Neofytides et al.* clearly outlines the steps of confirming a transaction (See col. 9, line 52, through col. 10, line 49). Finally, *Neofytides et al.* specifically contemplates that remote individuals periodically direct a reoccurring payment (See col. 1, line 57, through col. 2, line 2). In conjunction with this disclosure, *Neofytides et al.* discloses, teaches, and suggests incorporating authorized third parties (See col 6, lines 23-36). The Examiner maintains that all of Applicant's claims recite elements disclosed, taught, and suggested in *Neofytides et al.*